



17 APR 2008

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In re Application of

HOLDER et al.

U.S. Application No. 10/586,782

PCT No.: PCT/GB05/00227

Int. Filing Date: 21 January 2005

Priority Date: 21 January 2004

Attorney Docket No.: 642/07.01

For: FILLING MATERIAL

COMMUNICATION  
REGARDING  
SUBMISSION UNDER 37 CFR 1.42

This communication is issued in response to the Submission under 37 CFR 1.42 filed 26 November 2007. No petition fee is required.

### **BACKGROUND**

On 21 January 2005, applicant filed international application PCT/GB05/00227 which claimed priority to an earlier application filed 21 January 2004. A copy of the International Application was forwarded to the United States Patent and Trademark Office (USPTO) from the International Bureau (IB) on 04 August 2005. The thirty-month period for paying the basic national fee in the United States expired at midnight on 21 July 2006.

On 21 July 2006, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by the requisite basic national fee ; a copy of the international application; and a preliminary amendment.

On 19 April 2007, applicant was mailed a "Notification of Missing Requirements" (Form PCT/DO/EO/905) informing applicant that an executed oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required. Applicant was afforded two months to file the required response.

On 13 July 2007, applicant filed a petition under 37 CFR 1.47(a) to accept the filed declaration without the signature of joint inventor David Holder. In a decision dated 25 September 2007, applicant's petition under 37 CFR 1.47(a) was dismissed without prejudice.

On 26 November 2007, applicant filed a Submission under 37 CFR 1.42.

### DISCUSSION

37 CFR 1.42 *When the Inventor is Dead*, states, in part:

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

Section 409.01(a) of the Manual of Patent Examining Procedure (MPEP) states that the application can also be executed by "all of the heirs" of the deceased inventor, where no legal representative has been appointed.

The declaration submitted on 26 November 2007 was executed by Michael Reynolds and Anita Boardman as "representatives" of deceased inventor, David Alexander Holder. However, the declaration does not state that Michael Reynolds and Anita Boardman are the "legal" representatives or are all of the heirs of the deceased inventor. Accordingly, the declaration fails to identify the proper relationship under 37 CFR 1.497(b)(2).

37 CFR 1.497(b)(2) states the following:

(2) If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or § 1.47) the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence, and mailing address of the legal representative.

37 CFR 1.497(b)(2) requires that citizenship, mailing address, and residence information be provided for **both** the deceased inventor and the legal representative. Here, the declaration filed 26 November 2007 does not comply with 37 CFR 1.497(b)(2), discussed above, in that it does not include the citizenship of Michael Reynolds and Anita Boardman.

Because the declaration submitted does not include all the information required by 37 CFR 1.497(b)(2), the declaration cannot be accepted under 37 CFR 1.497 and 1.42.

### CONCLUSION

For the reasons discussed above, the request for status under 37 CFR 1.42 is **DISMISSED** without prejudice.

Applicants have **TWO (2) MONTHS** from the mailing date of this communication to submit a proper response under 37 CFR 1.42 and 37 CFR 1.497. Failure to provide a proper and timely response will result in abandonment. Extensions of time are available under 37 CFR 1.136(a).

A proper response must include a new declaration in compliance with 37 CFR 1.497 executed by the legal representative and including all the required information discussed above.

Any further correspondence with respect to this matter should be addressed to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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